

REMARKS

This Amendment is filed in response to the Final Action of July 8, 2009 in which claims 1-34 were rejected.

Claim Rejections- 35 U.S.C. 101

At section 2 of the Office Action, claims 27-32 are rejected under 35 U.S.C. 101 because it is asserted the claimed subject matter is directed to a non-statutory subject matter. Claims 27-32 recite “video information,” which is asserted to not impart functionality to a computer or computing device, and is considered nonfunctional descriptive material. Applicant respectfully disagrees.

The “video information” stored on the computer readable medium of claim 27 has a functional and structural interrelationship with a transmitter. The video information is stored on the computer readable medium and retrieved by the transmitter. Once retrieved, the video information is transmitted as a signal and there is a specific method claimed for comprising the signal. The method includes arranging macroblocks of each switching frames of a plurality of switching frames into first and second groups of macroblocks, encoding each macroblock of the first group of macroblocks by a first encoding method, and encoding macroblocks of the second group by a second encoding method. Thus, the video information, once retrieved from the computer readable medium, in part causes the method for forming the signal to occur. Therefore, the video information of claims 27-32 does impart functionality to a computing device, and the claims should be considered statutory.

At section 3 of the Office Action, claims 1-6 and 25 are rejected for not being directed to a statutory process. It is asserted that the claimed method neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. Applicant respectfully disagrees.

Claim 1 recites, “A method for transmitting video information from an encoder in which at least one bitstream is formed from the video information comprising a set of frames, the frames comprising macroblocks.” The claim clearly recites an encoder, a particular apparatus. Further, it is clear that the claimed method is tied to the encoder. For example, the method recites “forming a plurality of switching frames

into said bitstream,” immediately after reciting “an encoder in which one bitstream is formed.” The “forming a plurality of switching frames into said bitstream” is clearly being performed by the encoder, and cannot be interpreted as possibly being performed mentally or verbally. Further, the method recites “encoding each macroblock of said first group” and “encoding macroblocks of said second group.” These aspects of the method are also obviously tied to, and performed by, the claimed encoder. Claim 25 also recites such an encoder, and thus also claims the method being tied to an encoder.

Therefore, because claims 1-6 and 25 recite a method which is tied to a particular apparatus, an encoder in which at least one bitstream is formed from video information comprising a set of frames, it is respectfully submitted that these claims are directed to statutory subject matter.

Claim Rejections- 35 U.S.C. 103

At section 7 of the Office Action claims 1-3, 6-9, 12-15, 18-21, 24 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalby et al (US 6,002,440, hereinafter Dalby).

With respect to claim 1, Applicant respectfully disagrees with the assertions that Dalby discloses the various features of the claimed invention. It is asserted that Dalby discloses “arranging macroblocks of said each switching frame of said plurality of switching frames into a first group of macroblocks and a second group of macroblocks” at column 5, lines 32-53. This passage recites:

Thus a first set of data 10 representing the normal playback mode of a video signal is generated PPPPP . . . , together with a second set of data 20 representing a second playback mode (fast forward/fast reverse) I'IIIT'I . . . and a further set of data 30 P', P'', P''' allowing the normal playback mode bitstream 10 to be re-joined. These sets of data are stored in the local store 34 together with the associated control lists (to be discussed below) which record the links between the sets of data.

The intraframes for the fast forward/fast reverse playback mode are encoded at a reduced bit rate compared to that of the normal playback mode bitstream. Differences between the I'-frame and the frame of the normal playback mode bitstream linked to the I'-frame are then encoded to form an additional P' frame. The control unit 22 of the encoder has the freedom, for each macroblock in any additional P' frame, to modify the quantiser step size in the following manner. The encoder adds additional P frames after each I' frame that has been encoded as shown in FIG. 3 as P' P'' and P'''

respectively. The number of P frames encoded after each I frame is programmable at the time the material is encoded and is not fundamental to the invention.

There is nothing in this passage which would indicate to a skilled person that macroblocks of each switching frame are arranged into a first group of macroblocks and a second group of macroblocks. In Dalby, the macroblocks of one frame are encoded using the same encoding method, so there is only one group of macroblocks within each frame. The control unit may modify the quantizer step size so that additional P frames can be added after each I' frame (Dalby, Column 5, lines 46-52). However, the encoding method is still the same in each additional P frame and the quantizer step size is the same for each macroblock within one frame although the step size could differ between successive, additional P frames. Therefore, the claimed feature of arranging macroblocks of each switching frame of said plurality of switching frames into a first group of macroblocks and a second group of macroblocks is not taught by Dalby.

Furthermore, it is asserted that Dalby discloses wherein successive switching frames of said plurality of switching frames do not have corresponding groups of macroblocks encoded by said first encoding method, with reference to Figs. 3, 4 and 7. This feature is also not taught by Dalby because all the macroblocks within one switching frame are encoded by using the same encoding method wherein two successive switching frames inherently contain a corresponding group of macroblocks (i.e. all macroblocks within one frame) encoded by the same encoding method.

Therefore, for the aforementioned reasons, it is respectfully submitted that claim 1 is patentable over Dalby and is in allowable form.

For similar reasons, it is respectfully submitted that independent claims 7, 13, 19, 27, 33 and 34 are patentable over Dalby and are in allowable form.

In addition, the applicant would like to note that the Office's rejection of the claims based on Dalby under §103(a) is unclear. According to §706.02(j) of the MPEP:

After indicating that the rejection is under 35 U.S.C. 103, the examiner should set forth in the Office action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied

reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

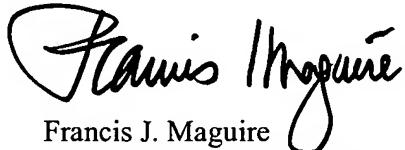
In the §103(a) rejections based on Dalby, the Office does not specify how it believes the invention in view of Dalby “is not identically disclosed or described as set forth in section 102.” The Office states that Dalby discloses “forming...,” “arranging...,” “encoding...,” and “encoding...” exactly as claimed, without specifying what differences it believes exist between the claims and Dalby. In furtherance of not explaining the perceived differences between the claims and the reference, the Office fails to state the proposed modification of Dalby that would arrive at the claimed subject matter and an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. In view of these deficiencies in the rejection, if the rejections are not withdrawn based on the arguments set forth above, Applicant respectfully requests a clarification or correction of the rejections under §103(a) based on the Dalby reference, so that Applicant may have an opportunity to fully respond to each issue. It is also requested in this connection that the finality of the rejection be withdrawn.

At Section 31 of the Office Action, claims 4, 5, 10, 11, 16, 17, 22, 23, 25, 26, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dalby in view of Gaylord (U.S. 6,956,600). However, Applicant respectfully submits that *Gaylord* is inapplicable as a 35 U.S.C. § 102/103 reference because its filing date (September 19, 2001) is well after at least the U.S. filing date (June 18, 2001) of U.S. Application Serial No. 09/883,887 (now U.S. Patent No. 6,765,963) from which priority is claimed, among others. Withdrawal of the obviousness rejection of these claims should therefore be withdrawn.

At least in view of their dependency on the independent claims, it is respectfully submitted that all dependent claims are in allowable form.

The rejections and objections of the Office Action of July 8, 2009, having been obviated by amendment or shown to be inapplicable, withdrawal thereof is requested and passage of claims 1-34 is earnestly solicited.

Respectfully submitted,



Francis J. Maguire
Attorney for the Applicant
Registration No. 31,391

FJM/mo
WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, Connecticut 06468
(203) 261-1234